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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 09/067, G38 | 04/27/98 | JOHN W CADFELL | |

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EXAMINER

REVIEWED BY: [Redacted]

ART UNIT

1633

PAPER NUMBER

DATE MAILED: 12/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|-----------------------------------|---------------------------------------|
| Office Action Summary | Application No. 09/067,638 | Applicant(s) Cowsert et al. |
| | Examiner Ardin Marschel | Group Art Unit 1634 |

Responsive to communication(s) filed on _____.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-46 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

CRF Diskette Problem Report

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because errors have been found in the submitted CRF sequence. See the enclosed CRF Diskette Problem Report. Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action.

Claims 1-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-46 are vague and indefinite because the preamble cites the generation of compounds that modulate expression confusingly without any steps that are directed to such modulation of expression. It is noted that defined criteria are cited but this phrase is so broad that its connection with modulation of expression is completely obscure and unclear. Do applicants intend that any generation of nucleobase sequences be a method within the scope of the claims with some other selection later and undefined in the claims to be imposed for modulation of expression? It is noted that generic biological etc. properties are cited in certain claims but again without any apparent

connection with the modulation of expression. It is additionally noted that antisense modulation is cited in claims 43 and 46 but as with the other claims no practice that clarifies what actual selection criteria is meant.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-46 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Peterson et al. (P/N 5,783,431).

Peterson et al. discloses the preparation of expression libraries in column 6, lines 40-53, which reads on the instant claims. The robotic screening for these library compounds is disclosed in column 14, lines 5-21. The disclosure as a whole details a variety of screening criteria that is encompassed by the instant claims. For example, the bridging paragraph between columns 34 and 35 cites selection of donor organisms for expression libraries based on biological properties or via known, that is, identified organisms or unidentified organisms. Column 36, lines 37-50, define selection criteria based on biosynthetic

pathways.

Applicants have submitted a PTO Form 1449 but without any copies of the references thereon cited. Therefore, this form is filed in the file but is unexecuted due to a lack of copies of the cited references.

The disclosure is objected to because of the following informalities:

In claim 6, last line, the word "oligonucleodites" appears to be misspelled.

Appropriate correction is required.

No claim is allowed.

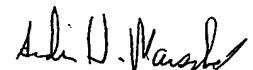
Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

December 21, 1998


ARDIN H. MARSCHEL
PRIMARY EXAMINER